

Request for Reconsideration after Final Action

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| SERIAL NUMBER | 85440869 | | |
| LAW OFFICE ASSIGNED | LAW OFFICE 101 | | |
| MARK SECTION (no change) | | | |
| ARGUMENT(S) | | | |
| <p>The Trademark Examining Attorney has maintained and made final her refusal to register Applicant's mark DJ MELEE pursuant to Section 2(d) of the Trademark Act on the grounds that Applicant's mark DJ MELEE for "Entertainment Services; namely live musical performances by a disc jockey; distribution of pre-recorded musical performances by a disc jockey rendered through radio, TV, video, satellite or the internet; production and remixing of musical recordings; performances by a disc jockey for parties, nightclubs, concerts, festivals and special events; audio and videotape recording and production services; audio and videotape recording and production services; recording, production and directing of musical performances" ("Applicant's Mark") is likely to be confused with the following <u>two</u> U.S. Trademark registrations of unrelated parties:</p> | | | |
| <u>Mark</u> | <u>Reg. No.</u> | <u>Owner</u> | <u>Goods/Services</u> |
| MELEE | 3,317,603 | A California Partnership Comprised of Christopher Cron, Richard Sanberg, Ryan Malloy and Michael Nader | Entertainment namely, live performances by a musical band |
| MELEE | 3,042,420 | Melee Entertainment LLC | compact discs featuring music, musical performances, action, comedy, drama, sports, instruction and animated programs; printed matter and paper goods, namely, comic books, |

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| | | children's books, coloring books, children's activity books, fiction, nonfiction, adventure and animation books, fiction nonfiction adventure, animation and children's magazines; stationery, writing paper, envelopes, notebooks, personal diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils and cases therefore, erasers, crayons, markers, colored pencils, arts and crafts painting kits; chalk and chalkboards for school and home use; decals, paper based iron on transfers; posters; photographs; book covers, book marks, and calendars; entertainment services in the nature of on-going live- action, musical, comedy, drama and/or animated television programs and movies; production of live- action, musical, comedy, action and animated motion picture films for television and movies; distribution of motion pictures, rental of pre-recorded video tapes, pre- recorded video discs, pre-recorded digital video discs, pre-recorded audiotape and pre-recorded compact discs; production and distribution of musical sound and video recordings; organizing and promoting live musical events |
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(the "Cited Registrations").

The Examining Attorney has refused registration on the basis that the dominant feature of the Applicant's Mark and the dominant feature of the marks in the Cited Registrations is the term MELEE and that the services of the respective parties are similar in kind and/or closely related. The Applicant respectfully disagrees with the Trademark Examining Attorney and requests reconsideration of her refusal to register for the following reasons:

1. Properly considered in their entirety, the commercial impression created by Applicant's Mark is dissimilar from the marks in the Cited Registrations that confusion is unlikely;
2. Applicant's services and the services set forth in the Cited Registration are not related in any way and are sold in completely difference channels of trade;
3. The marks in the Cited Registrations which are identical and owned by presumably unrelated third parties, co-exists on the Register; and
4. Purchasers of Applicant's services comprise a special class and are

discriminating purchasers.

DISCUSSION

It has long been the law that allegedly conflicting composite marks are to be compared by looking at them as a whole, rather than breaking them up into their component parts for comparison. The United States Supreme Court has stated that “the commercial impression of a mark is derived from it **as a whole**, not from its elements separated and considered in detail.” Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 64 L. Ed. 705, 40 S. Ct. 414 (1920). “The marks must be viewed as the public views them. That is, in their entireties.” In re National Data Corporation, 224 USPQ 749 (CAFC 1985).

Further, it is a violation of the anti-dissection rule to focus on one feature of a mark, as the Examiner has done here, and find likelihood of confusion solely on that feature, ignoring the other elements of the mark. See Spice Islands, Inc. v. The Frank Tea and Spice Company, 18 USPQ 35 (CCPA 1974) (SPICE ISLANDS with a “Tree design confusingly similar to SPICE TREE). “Arguments to the effect that one portion of a mark possesses no trademark significance leading to a discrete comparison between only what remains is an erroneous approach.” Id. Accordingly, the Examiner must take into consideration all elements of the Applicant’s mark and the cited mark, including **all** of the additional words contained in the Applicant’s Mark and the cited marks, in determining likelihood of confusion.

In the first instance, Applicant’s mark is a distinctive composite mark comprised of the words DJ MELEE. Most significantly, the term DJ in the Applicant’s Mark has a specific meaning in connection with Applicant’s services.

A disc jockey, also known as DJ, is a person who selects and plays recorded music for an audience. See Exhibit 1. There are several types of disc jockeys. Id. Radio DJs or radio personalities introduce and play music that is broadcast on AM, FM, shortwave, digital, or internet radio stations. Id. Club DJs select and play music in bars, nightclubs, or discothèques, or at parties or raves, or even in stadiums. Id. Hip hop disc jockeys select and play music using multiple turntables, often to back up one or more MCs, and they may also do turntable scratching to create percussive sounds. Id. In reggae, the DJ (deejay) is a vocalist who raps, “toasts”, or chats over pre-recorded rhythm tracks while the individual choosing and playing

them is referred to as a selector. Id. Mobile DJs travel with portable sound systems and play recorded music at a variety of events. Id. Based on this special meaning of the term DJ, when such term is used in connection with Applicant's mark DJ MELEE, it will be recognized by consumers as identifying a special and unique genre of music.

In contrast, the marks in the Cited Registrations do not contain the term DJ. Thus, purchasers encountering the marks in the Cited Registrations will ascribe no special or unique genre of music to the services set forth in the registrations. As such Applicant's Mark -- DJ MELEE -- is not likely to be confused with the marks cited by the Examiner.

Differences in connotation and meaning are significant factors in deciding likelihood of confusion and, in most cases, can be determinative, even when both marks include identical words. Champagne Louis Roederer, S.A. v. Delicato Vineyards, 47 USPQ2d 1495 (Fed. Cir. 1998) (stating that one factor may be dispositive of likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks and finding no likelihood confusion between CRYSTAL and CRYSTAL CREEK where the marks evoked very different images); Kellogg Co. v. Pack'em Enters., 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991) (stating that "we know of no reason why, in a particular case, a single factor may not be dispositive" and holding that "substantial and undisputed differences" between two competing marks -- FROOT LOOPS and FROOTEE ICE -- justified a conclusion of no likelihood of confusion); Keebler Co. v. Murray Bakery Products, 9 USPQ2d 1736 (Fed. Cir. 1989) (agreeing with the Board that the "more important fact for resolving the issue of likelihood of confusion ... is the dissimilarity in commercial impression between the marks.").

In Consolidated Cigar Corp. v. R.J. Reynolds Tobacco Co., 181 U.S.P.Q. 44 (CCPA 1974), the Court affirmed the Board's decision that there was no likelihood of confusion between the marks DUTCH MASTERS and DUTCH APPLE, both for pipe tobacco and cigars because the connotations thereof were sufficiently different. The determination of no likelihood of confusion was made irrespective of the fact that the goods of the parties were those that a single producer might be expected to make, and that both marks included the word "DUTCH." The Court stated that, notwithstanding the similarity of the goods, "it does not automatically follow that the purchasers of appellee's pipe tobacco might well be confused

and think that appellant, the producer of cigars, was the source.” Id. at 45. Rather, the Court considered as a determinative factor, the fact that the marks conveyed different meanings:

Considering appellant’s mark as a whole, it is apparent that it suggests both a geographical area or an ethnic association and a masterful product (cigars). Appellee’s mark, on the other hand, suggests both the same geographical area or ethnic association and an apple-flavored product (smoking tobacco), which is clearly dissimilar in meaning to a masterful product.

Id.

Similarly, in Colgate-Palmolive Co. v. Carter-Wallace, Inc., 167 USPQ. 529 (CCPA 1970), the Court affirmed the Board’s finding of no likelihood of confusion between the marks PEAK for dentifrice and PEAK PERIOD for deodorants. In so holding, the Court quoted with approval the board’s reasoning that the noun PEAK conveys a number of meanings, such as the top of a hill or mountain, whereas the addition of the word “period” to PEAK, resulted in a mark that conveyed a different meaning, such as the meaning of reaching the high point or maximum of an activity during a specified portion of time, “a meaning which is substantially different than that elicited by the word “peak” alone.” Id. at 530. Moreover, the Court emphasized that the presence in both marks of a common word, i.e., “peak,” was not, in and of itself, sufficient to render the marks similar, since their differences in sound, appearance and meaning were still greater than their similarities:

We agree with the board that the mere presence of the word “peak” in the trademark PEAK PERIOD does not by reason of that fact alone create a likelihood of confusion or deception. That determination must arise from a consideration of the respective marks in their entireties. The difference in appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike.

Id. Such distinction applies equally in the present case.

In addition, Applicant’s services and the services set forth in the Cited Registrations are not related in any way and are sold in completely difference channels of trade to completely different purchasers.

The Examiner appears to have reasoned that the Applicant’s services and the services listed in the Cited Registrations are all related to music and therefore are similar in kind and/or closely related. However, the nature and scope of a party’s goods or services must be determined on the basis of the goods or services as recited in the application or registration.

Hewlette-Packard Co. v. Packard Press, Inc., 281 F.3d 1261 (Fed. Cir. 2006). Applicant's services do not encompass every type of music. Applicant's services, as set forth in the subject application, relate to a specific type of musical genre namely, music performed by a disc jockey. As stated more fully above, a disc jockey, also known as DJ, is a person who selects and plays recorded music for an audience.

Applicant uses the mark DJ MELEE in connection with his disc jockey services featuring breaks, electro, tech-house and dubstep music, all of which falls under the tech funk umbrella of music. Applicant has performed under the mark DJ MELEE at many music festivals, night clubs and concerts. Specifically, Applicant has performed at Miami's internationally known Winter Music Conference, as the opening act with numerous world-famous famous DJ, was the resident DJ at Boston's award winning Avalon night club and currently performs at Royale Boston

In contrast, the types of musical services set forth in the Cited Registrations, are not for the same genre of music as Applicant's services. Specifically, Reg. No. 3,317,603 is for "entertainment namely, live performances by a musical band." In contrast to a disc jockey, a musical band or musical ensemble is comprised of a group of people who perform instrumental or vocal music. More, specifically, the owner of the cited registration describes its musical band as a rock band which performs completely different genre of music than Applicant. In addition, Reg. No. 3,042,420 entertainment services are related to "live-action, musical, comedy, action and animated motion picture films" and not the same genre of music as listed in the subject application.

Many courts have found no likelihood of confusion where the music genres differ between the mark holders, including M2 Software, Inc. v. Madacy Entertainment, 421 F.3d 1073 (9th Cir. 2005) (no likelihood of confusion between sports music and interactive music distributors); M2 Software, Inc. v. M2 Communications, L.L.C., 149 Fed.Appx. 612 (9th Cir. 2005) (no likelihood of confusion between interactive music and Christian music distributors) and Echo Drain v. Newsted, 307 F.Supp.2d 1116 (C.D. Cal.2003) (no likelihood of confusion, in part, because of difference between "funk and groove" and pop music genres).

Given the different genres of music at issue here, confusion between the Applicant's

Mark and the marks in the Cited Registrations is not likely.

Furthermore, Applicant believes that there is sufficient evidence of dilution of the term "MELEE" on the register, in the relevant fields. As such, the additional matter contained in the subject marks and the differences in services makes it unlikely that Applicant's Mark will be confused with the marks in the Cited Registrations.

Applicant submits that the Office has permitted the registration of marks incorporating the term MELEE in the musical and entertainment services fields of unrelated parties to co-exist on the register. In particular, Applicant respectfully points out the co-existence of the two Cited Registrations owed by two different and presumably unrelated entities, both of which are for the **identical** mark MELEE.

Mark: MELEE
Reg. No.: 3,317,603
Reg. Date.: October 23, 2007
Owner: A California Partnership Comprised of Christopher Cron, Richard Sanberg, Ryan Malloy and Michael Nader
For: Entertainment namely, live performances by a musical band

Mark: MELEE
Reg. No.: 3042420
Reg. Date.: January 10, 2006
Owner: Melee Entertainment LLC
For: pre-recorded video tapes, video discs, digital video discs, audiotapes and compact discs featuring music, musical performances, action, comedy, drama, sports, instruction and animated programs; printed matter and paper goods, namely, comic books, children's books, coloring books, children's activity books, fiction, nonfiction, adventure and animation books, fiction nonfiction adventure, animation and children's magazines; stationery, writing paper, envelopes, notebooks, personal diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils and cases therefore, erasers, crayons, markers, colored pencils, arts and crafts painting kits; chalk and chalkboards for school and home use; decals, paper based iron on transfers; posters; photographs; book covers, book marks, and calendars; entertainment services in the nature of on-going live- action, musical, comedy, drama and/or animated television programs and movies; production of live- action, musical, comedy, action and animated motion picture films for television and movies; distribution of motion pictures, rental of pre-recorded video tapes, pre- recorded video discs, pre-recorded digital video discs, pre-recorded audiotape and pre-recorded compact discs; production and distribution of musical sound and video recordings; organizing and promoting live musical events

The TESS/TARR records for these registrations have previously been made of record.

The Applicant respectfully submits that the existence of the third party registrations listed above, both of which are for the **identical** mark MELEE, show that that the Office recognizes the weaknesses of the common term MELEE and that its distinctiveness in the customer's mind is blurred.

It is clear that by permitting marks of unrelated parties which are comprised of or contain the term MELEE of unrelated parties to co-exist on the register, the Office further recognizes that such marks have a very limited scope of protection and that other elements in the marks or differences in their respective goods or services, however minor, are sufficient to avoid confusion. American Hospital Supply v. Air Products and Chemicals, 194 USPQ 340 (TTAB 1977). "Generally the addition of other matter to a highly suggestive or descriptive designations, **whether such matter be equally suggestive or descriptive, or possibly nothing more than a variant of the term** may be sufficient to distinguish between them so as to avoid confusion in the trade." In re Hunke & Jochheim, 184 USPQ 188 (TTAB 1975)(emphasis added). Persons encountering the respective marks would attribute to the terms their well-known meaning and would not be likely to associate the goods or services of one party with those of the other. The Murray Corporation of America v. Red Spot Paint and Varnish Co., Inc., 126 USPQ 390 (CCPA 1960) (Third party registrations that incorporate a common term indicate that the term has a primarily suggestive or descriptive significance as applied to the goods in the registrations. If such term has been frequently used in trademarks of others, an inference is warranted that the term is not purely arbitrary). See also Conde Nast Publications, Inc. v. Miss Quality, Inc., 184 USPQ 422 (CCPA 1975), (finding no confusion between the marks VOGUE for a women's fashion magazine and COUNTRY VOGUES for dresses on the basis that the consumer encountering the mark COUNTRY VOGUES "in the marketing environment generally surrounding the sale of goods of this type would, in the context in which it is used, attribute to the term VOGUES its normal and well-known meaning and would not, in any way, associate this apparel with the publisher of VOGUE magazine." Id. at 425. On this basis, the Court found no confusion, even though VOGUE magazine regularly featured "pattern numbers" for "dresses.").

Applying these well established tenets of trademark law to the present case, the Applicant submits that registration of its mark DJ MELEE with its visually perceptible differences from those of the cited marks and the differences in services, should not be denied on the basis of likelihood of consumer confusion with the cited registrations for the marks MELEE.

Additionally, the Applicant submits that in the case of all marks, the consumers of the respective services are likely to be sophisticated and informed consumers who are unlikely to be confused by Applicant's Mark. In evaluating likelihood of confusion, consideration must also be given to the degree of care likely to be exercised by purchasers. Litton Systems, Inc. v. Whirlpool Corp., 221 USPQ 97 (Fed. Cir. 1984). Likelihood of confusion is diminished where, as here, the prospective purchasers of Applicant's services are sophisticated individuals who are inclined to exercise a greater degree of care. McGregor-Doniger, Inc. v. Drizzle, Inc., 202 USPQ 81 (2d Cir. 1979); Kiekhoefer Corp. v. Willys-Overland Motors, Inc., 111 USPQ 105 (CCPA 1956).

Customers purchasing goods and services related to the music and entertainment filed do so only after careful consideration. The Applicant further submits that the services described in his application are directed to a discriminating and special class of purchasers (i.e. individuals that follow DJ MELEE and his music). Goods and services bearing a popular insignia, whether it is of a celebrity, a movie, a beer, a music group or a DJ, are purchased only by fans that, by definition, are knowledgeable about the source or sponsorship of the goods or services.

It is well established that when buyers exercise a higher standard of care in making purchasing decisions, confusion is not likely to occur. See In re Shipp, 4 USPQ 2d 1174 (TTAB 1987); See also Kiekhoefer Corporation v. Willys-Overland Motors, Inc., 111 USPQ 105 (CCPA 1956)(less likelihood of confusion when goods are purchased after careful consideration versus carelessly). See McCarthy on Trademarks, § 23:96 (the more care that is taken, the less likelihood of confusion). Because of these consumers' special nature, they can be considered to be reasonably discriminating buyers (as opposed to normal reasonable prudent or ordinary buyers) and they are not likely, therefore, to be confused as to the source of the

services.

Based on the foregoing, Applicant respectfully requests that the Examiner reconsider her refusal and pass the application to publication.

In any matter which will advance the prosecution of this case, the Trademark Examining Attorney is requested to call the undersigned at (305) 704-3980.

SIGNATURE SECTION

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| RESPONSE SIGNATURE | /Amy B. Spagnole-DeRosa/ |
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| SIGNATORY'S NAME | Amy B. Spagnole-DeRosa |
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| SIGNATORY'S POSITION | Attorney of Record, FL Bar Member |
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| SIGNATORY'S PHONE NUMBER | 305-704-3980 |
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| DATE SIGNED | 03/04/2013 |
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| AUTHORIZED SIGNATORY | YES |
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| CONCURRENT APPEAL NOTICE FILED | NO |
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FILING INFORMATION SECTION

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Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85440869** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Trademark Examining Attorney has maintained and made final her refusal to register

Applicant's mark DJ MELEE pursuant to Section 2(d) of the Trademark Act on the grounds that Applicant's mark DJ MELEE for "Entertainment Services; namely live musical performances by a disc jockey; distribution of pre-recorded musical performances by a disc jockey rendered through radio, TV, video, satellite or the internet; production and remixing of musical recordings; performances by a disc jockey for parties, nightclubs, concerts, festivals and special events; audio and videotape recording and production services; audio and videotape recording and production services; recording, production and directing of musical performances" ("Applicant's Mark") is likely to be confused with the following two U.S. Trademark registrations of unrelated parties:

| Mark | Reg. No. | Owner | Goods/Services |
|-------------|-----------------|--|---|
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| | | recorded audiotape and pre-recorded compact discs; production and distribution of musical sound and video recordings; organizing and promoting live musical events |
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(the “Cited Registrations”).

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2. Applicant’s services and the services set forth in the Cited Registration are not related in any way and are sold in completely different channels of trade;
3. The marks in the Cited Registrations which are identical and owned by presumably unrelated third parties, co-exists on the Register; and
4. Purchasers of Applicant’s services comprise a special class and are discriminating purchasers.

DISCUSSION

It has long been the law that allegedly conflicting composite marks are to be compared by looking at them as a whole, rather than breaking them up into their component parts for comparison. The United States Supreme Court has stated that “the commercial impression of a mark is derived from it **as a whole**, not from its elements separated and considered in detail.” Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 64 L. Ed. 705, 40 S. Ct. 414 (1920). “The marks must be viewed as the public views them. That is, in their entirety.” In re National Data Corporation, 224 USPQ 749 (CAFC 1985).

Further, it is a violation of the anti-dissection rule to focus on one feature of a mark, as the Examiner has done here, and find likelihood of confusion solely on that feature, ignoring the other elements of the mark. See Spice Islands, Inc. v. The Frank Tea and Spice Company, 18

USPQ 35 (CCPA 1974) (SPICE ISLANDS with a "Tree design confusingly similar to SPICE TREE). "Arguments to the effect that one portion of a mark possesses no trademark significance leading to a discrete comparison between only what remains is an erroneous approach." Id. Accordingly, the Examiner must take into consideration all elements of the Applicant's mark and the cited mark, including all of the additional words contained in the Applicant's Mark and the cited marks, in determining likelihood of confusion.

In the first instance, Applicant's mark is a distinctive composite mark comprised of the words DJ MELEE. Most significantly, the term DJ in the Applicant's Mark has a specific meaning in connection with Applicant's services.

A disc jockey, also known as DJ, is a person who selects and plays recorded music for an audience. See Exhibit 1. There are several types of disc jockeys. Id. Radio DJs or radio personalities introduce and play music that is broadcast on AM, FM, shortwave, digital, or internet radio stations. Id. Club DJs select and play music in bars, nightclubs, or discothèques, or at parties or raves, or even in stadiums. Id. Hip hop disc jockeys select and play music using multiple turntables, often to back up one or more MCs, and they may also do turntable scratching to create percussive sounds. Id. In reggae, the DJ (deejay) is a vocalist who raps, "toasts", or chats over pre-recorded rhythm tracks while the individual choosing and playing them is referred to as a selector. Id. Mobile DJs travel with portable sound systems and play recorded music at a variety of events. Id. Based on this special meaning of the term DJ, when such term is used in connection with Applicant's mark DJ MELEE, it will be recognized by consumers as identifying a special and unique genre of music.

In contrast, the marks in the Cited Registrations do not contain the term DJ. Thus, purchasers encountering the marks in the Cited Registrations will ascribe no special or unique genre of music to the services set forth in the registrations. As such Applicant's Mark -- DJ MELEE -- is not likely to be confused with the marks cited by the Examiner.

Differences in connotation and meaning are significant factors in deciding likelihood of confusion and, in most cases, can be determinative, even when both marks include identical words.

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Applicant uses the mark DJ MELEE in connection with his disc jockey services featuring breaks, electro, tech-house and dubstep music, all of which falls under the tech funk umbrella of music. Applicant has performed under the mark DJ MELEE at many music festivals, night clubs and concerts. Specifically, Applicant has performed at Miami’s internationally known Winter Music Conference, as the opening act with numerous world-famous famous DJ, was the resident DJ at Boston’s award winning Avalon night club and currently performs at Royale Boston

In contrast, the types of musical services set forth in the Cited Registrations, are not for

the same genre of music as Applicant's services. Specifically, Reg. No. 3,317,603 is for "entertainment namely, live performances by a musical band." In contrast to a disc jockey, a musical band or musical ensemble is comprised of a group of people who perform instrumental or vocal music. More, specifically, the owner of the cited registration describes its musical band as a rock band which performs completely different genre of music than Applicant. In addition, Reg. No. 3,042,420 entertainment services are related to "live-action, musical, comedy, action and animated motion picture films" and not the same genre of music as listed in the subject application.

Many courts have found no likelihood of confusion where the music genres differ between the mark holders, including M2 Software, Inc. v. Madacy Entertainment, 421 F.3d 1073 (9th Cir. 2005) (no likelihood of confusion between sports music and interactive music distributors); M2 Software, Inc. v. M2 Communications, L.L.C., 149 Fed.Appx. 612 (9th Cir. 2005) (no likelihood of confusion between interactive music and Christian music distributors) and Echo Drain v. Newsted, 307 F.Supp.2d 1116 (C.D. Cal.2003) (no likelihood of confusion, in part, because of difference between "funk and groove" and pop music genres).

Given the different genres of music at issue here, confusion between the Applicant's Mark and the marks in the Cited Registrations is not likely.

Furthermore, Applicant believes that there is sufficient evidence of dilution of the term "MELEE" on the register, in the relevant fields. As such, the additional matter contained in the subject marks and the differences in services makes it unlikely that Applicant's Mark will be confused with the marks in the Cited Registrations.

Applicant submits that the Office has permitted the registration of marks incorporating the term MELEE in the musical and entertainment services fields of unrelated parties to co-exist on the register. In particular, Applicant respectfully points out the co-existence of the two Cited Registrations owed by two different and presumably unrelated entities, both of which are for the **identical** mark MELEE.

Mark: MELEE

Reg. No.: 3,317,603

Reg. Date.: October 23, 2007

Owner: A California Partnership Comprised of Christopher Cron, Richard Sanberg, Ryan Malloy and Michael Nader

For: Entertainment namely, live performances by a musical band

Mark: MELEE
Reg. No.: 3042420
Reg. Date.: January 10, 2006
Owner: Melee Entertainment LLC

For: pre-recorded video tapes, video discs, digital video discs, audiotapes and compact discs featuring music, musical performances, action, comedy, drama, sports, instruction and animated programs; printed matter and paper goods, namely, comic books, children's books, coloring books, children's activity books, fiction, nonfiction, adventure and animation books, fiction nonfiction adventure, animation and children's magazines; stationery, writing paper, envelopes, notebooks, personal diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils and cases therefore, erasers, crayons, markers, colored pencils, arts and crafts painting kits; chalk and chalkboards for school and home use; decals, paper based iron on transfers; posters; photographs; book covers, book marks, and calendars; entertainment services in the nature of on-going live- action, musical, comedy, drama and/or animated television programs and movies; production of live- action, musical, comedy, action and animated motion picture films for television and movies; distribution of motion pictures, rental of pre-recorded video tapes, pre-recorded video discs, pre-recorded digital video discs, pre-recorded audiotape and pre-recorded compact discs; production and distribution of musical sound and video recordings; organizing and promoting live musical events

The TESS/TARR records for these registrations have previously been made of record.

The Applicant respectfully submits that the existence of the third party registrations listed above, both of which are for the **identical** mark MELEE, show that that the Office recognizes the weaknesses of the common term MELEE and that its distinctiveness in the customer's mind is blurred.

It is clear that by permitting marks of unrelated parties which are comprised of or contain the term MELEE of unrelated parties to co-exist on the register, the Office further recognizes that such marks have a very limited scope of protection and that other elements in the marks or differences in their respective goods or services, however minor, are sufficient to avoid confusion. American Hospital Supply v. Air Products and Chemicals, 194 USPQ 340 (TTAB 1977). "Generally the addition of other matter to a highly suggestive or descriptive designations, **whether such matter be equally suggestive or descriptive, or possibly nothing more than a variant of the term** may be sufficient to distinguish between them so as to avoid confusion in

the trade.” In re Hunke & Jochheim, 184 USPQ 188 (TTAB 1975)(emphasis added). Persons encountering the respective marks would attribute to the terms their well-known meaning and would not be likely to associate the goods or services of one party with those of the other. The Murray Corporation of America v. Red Spot Paint and Varnish Co., Inc., 126 USPQ 390 (CCPA 1960) (Third party registrations that incorporate a common term indicate that the term has a primarily suggestive or descriptive significance as applied to the goods in the registrations. If such term has been frequently used in trademarks of others, an inference is warranted that the term is not purely arbitrary). See also Conde Nast Publications, Inc. v. Miss Quality, Inc., 184 USPQ 422 (CCPA 1975), (finding no confusion between the marks VOGUE for a women’s fashion magazine and COUNTRY VOGUES for dresses on the basis that the consumer encountering the mark COUNTRY VOGUES “in the marketing environment generally surrounding the sale of goods of this type would, in the context in which it is used, attribute to the term VOGUES its normal and well-known meaning and would not, in any way, associate this apparel with the publisher of VOGUE magazine.” Id. at 425. On this basis, the Court found no confusion, even though VOGUE magazine regularly featured “pattern numbers” for “dresses.”).

Applying these well established tenets of trademark law to the present case, the Applicant submits that registration of its mark DJ MELEE with its visually perceptible differences from those of the cited marks and the differences in services, should not be denied on the basis of likelihood of consumer confusion with the cited registrations for the marks MELEE.

Additionally, the Applicant submits that in the case of all marks, the consumers of the respective services are likely to be sophisticated and informed consumers who are unlikely to be confused by Applicant’s Mark. In evaluating likelihood of confusion, consideration must also be given to the degree of care likely to be exercised by purchasers. Litton Systems, Inc. v. Whirlpool Corp., 221 USPQ 97 (Fed. Cir. 1984). Likelihood of confusion is diminished where, as here, the prospective purchasers of Applicant’s services are sophisticated individuals who are included to exercise a greater degree of care. McGregor-Doniger, Inc. v. Drizzle, Inc., 202 USPQ 81 (2d Cir. 1979); Kiekhoefer Corp. v. Willys-Overland Motors, Inc., 111 USPQ 105 (CCPA 1956).

Customers purchasing goods and services related to the music and entertainment filed do so only after careful consideration. The Applicant further submits that the services described in his application are directed to a discriminating and special class of purchasers (i.e. individuals that follow DJ MELEE and his music). Goods and services bearing a popular insignia, whether it is of a celebrity, a movie, a beer, a music group or a DJ, are purchased only by fans that, by definition, are knowledgeable about the source or sponsorship of the goods or services.

It is well established that when buyers exercise a higher standard of care in making purchasing decisions, confusion is not likely to occur. See In re Shipp, 4 USPQ 2d 1174 (TTAB 1987); See also Kiekhaefer Corporation v. Willys-Overland Motors, Inc., 111 USPQ 105 (CCPA 1956)(less likelihood of confusion when goods are purchased after careful consideration versus carelessly). See McCarthy on Trademarks, § 23:96 (the more care that is taken, the less likelihood of confusion). Because of these consumers' special nature, they can be considered to be reasonably discriminating buyers (as opposed to normal reasonable prudent or ordinary buyers) and they are not likely, therefore, to be confused as to the source of the services.

Based on the foregoing, Applicant respectfully requests that the Examiner reconsider her refusal and pass the application to publication.

In any matter which will advance the prosecution of this case, the Trademark Examining Attorney is requested to call the undersigned at (305) 704-3980.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Amy B. Spagnole-DeRosa/ Date: 03/04/2013

Signatory's Name: Amy B. Spagnole-DeRosa

Signatory's Position: Attorney of Record, FL Bar Member

Signatory's Phone Number: 305-704-3980

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing

him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

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